

**REMARKS**

Claims 1-17 and 32-44 are currently pending in the application. Applicants request reconsideration of the application in light of the following remarks.

**Telephone Interview Request**

Applicant's attorney attempted to schedule a telephone interview with the Examiner twice and left messages for the Examiner but was unable to make telephone contact with the Examiner prior to the due date for this Office Action response. Applicant requests that once the Examiner has received this Office Action, the Examiner contact Applicant's attorney to discuss the case by telephone.

**Rejections under 35 U.S.C. §103**

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims 1-17 and 32-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Donohue (U.S. Patent No. 6,262,171, hereinafter “Donohue”), in light of Atkins (U.S. Patent No. 5,644,727, hereinafter “Atkins”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Claims 1-11

The most recent Office Action cites Donohue as an “investment machine for public use and display” comprising a housing, a display, a microprocessor and a user identifier (“signature verification zone”). The Office Action also acknowledges that Donohue does not teach any **money receiver**, is not **configured to receive or identify any money to be invested**, and the processor is not configured to receive input from the investor representative of the **investor’s current investment preferences** or to transmit a signal representative of the input for use in investing in association with the unique identifier.

Applicant notes that Donohue is silent on investments and is not an investment machine at all. Rather, it is nothing more than an interface to a microprocessor for use in public. There is nothing in Donohue to teach or suggest its use with investments or as an investment machine such as that claimed by Applicant. At best, Donohue discloses nothing more than a fancy ATM for durable public use of a touch pad. *See* Donohue, col. 4, lines 44-55. In fact, even the “signature verification zone” does not necessarily “identify” the user as proposed in the most recent Office Action. There is nothing in Donohue to suggest that it is by the signature that the user is identified. Even taking the title as an accurate description, though the disclosure is unclear as to what the “signature verification zone” actually does or how it works, once the user is identified by other undisclosed means, the signature is perhaps only compared against another signature associated with the identified person to see if the signature is similar. It could never be a “unique identifier from an investor” as recited in claim 1.

For the components missing from Donohue, the most recent Office Action references Atkins. However, Atkins discloses only a software system for tracking financial accounts and requesting transactions. A combination of Atkins with Donohue, though there is no teaching, suggestion or motivation to do so in the references (Donohue is not an investment machine), does not teach or suggest an investment machine “configured to receive and identify money to be invested” as recited by claim 1. Even if it were obvious to combine the teachings of Atkins with Donohue, and Applicant maintains it is not, incorporation of the investment system of Atkins into the Kiosk-like housing of Donohue would result only in a system whereby a customer could view accounts and make investment requests from the terminal as indicated on page 4 of the Office Action. No money would be received or identified by the combined system. The Atkins transactions tracking and request system is only for remotely allocating funds for a particular transaction and tracking the histories of transactions, not for receiving investment money. When combined with Donohue, the combined invention would still only track and allocate funds from one account within the bank to another account. Therefore, independent claim 1 is not made obvious by and is allowable over the combination of Donohue and Atkins.

The large jump from the system of Atkins and attempts to combine it with a system like Donohue cannot be made without hindsight reconstruction from a review of Applicant’s disclosure, and is reminiscent of the Office Action rejecting the same claims made Feb. 19, 2002. Applicant refers the Examiner to Applicant’s response to that Office Action, which response was filed April 26, 2002. The system invented by Applicant as recited by claim 1 fills a need not previously found in the art by designing an affordable publically accessible investment machine which can accept even small amounts of money at the machine for investment according to the investor’s current preferences.

Claims 2-11 are allowable over the combination of Donohue and Atkins, among other reasons, for depending from allowable claim 1.

Claims 12-14

Claim 12 recites, “receiving money at an investment machine from the at least one person”. As explained in the most recent Office Action in great detail on pages 12-14, the system of Atkins discloses a method of investing money whereby the user logs onto the central computer system, transmits a transaction request to the “master central computer, where the order is received and processed” which includes memory for storing information on client asset accounts from which funds can be transferred (as mortgage loans) and an investment account to which loan funds can be transferred for investing. *See* Office Action, page 13, middle (referencing Atkins col. 76, lines 10-20). The user can then make additional transaction requests and transfer more money between accounts (or take out additional loans for cash), and track all of the transactions.

Atkins does not, however, teach or suggest use of a money receiver at any investment machine as recited by claim 12. For the level of investments and transactions being tracked by Atkins, it would not make sense to have a money receiver, which is conventionally used to receive small amounts of money rather than large amounts. The Atkins accounts are already at the master central computer when the user logs onto the system. The user’s computer does not receive any money. Accordingly, a combination of the teachings of Atkins with the touch pad kiosk of Donohue, while Applicant maintains it would not be obvious, does not provide any teaching or suggestion for a money receiver for use in an investment machine either. Claim 12 is, therefore, not obvious in light of and is allowable over Atkins and Donohue. Claims 13-14 are allowable over the combination of Atkins and Donohue, among other reasons, for depending from allowable claim 12.

Claims 15-17

Claim 15 recites a method of investing money using an investment machine, the method comprising “placing money to be invested into the investment machine . . . .” The combined teachings of Atkins and Donohue, though Applicant maintains there is no teaching or suggestion to combine, does not teach to have a user place “money to be invested” into the machine. Rather, as taught by Atkins, even if a combined system were devised (though there is no reason to do it from the teachings of the references), the user would merely approach the combined system and use it in the same way the Atkins system was used (but perhaps now with a touch pad). In Atkins, the accounts already exist at a bank or investment house somewhere and the user merely remotely transfers the money between accounts using the tracking system. The method of Atkins does not involve the user “placing **money** to be invested **into** the investment machine.”

The Office Action references Atkins col. 42, line 55 to imply that an ATM could act as the user interface for the Atkins system. This implication, however, is incorrect. Atkins explains, beginning at col. 44, line 47 through line 67, that through the standard user interface of Atkins, the user can order transactions that are executed through means of payment other than mere transfer between accounts. Suggestions provided by which the previously ordered transactions may be later executed include payroll debits, ATMs, interactive television, telephone, and a personal computer. This is not to provide additional ability to request orders through those media, but merely to allow the user additional trackable options for receiving the money from an ordered mortgage loan. This is more fully clarified at col. 44, line 64 of Atkins where it states that “upon the collection or failure to receive the required funds, updated reports are issued to the individual data file, the mortgage servicing department’s data file and the master history file 216.” Thus, if the user indicates through the Atkins system that it will later pick up the money at an ATM and fails to do so, a record is made and updated reports are issued to the user’s file to further track the money.

Nevertheless, the use of the ATM referenced still does not involve the user “placing money to be invested into the investment machine” as recited by claim 15. Accordingly, independent claim 15 is allowable over and not made obvious by the combination of Donohue and Atkins. Dependent claims 16-17 are allowable over the combination, among other reasons, for depending from allowable claim 15.

Claims 32-34

Claim 32 recites a method of investing money using an investment machine that is more specific than claim 15. Claim 32 recites placing at least one of a “coin” and a “bill” **into** the investment machine. As stated in support of claim 15, the combination of Atkins and Donohue, which does not teach or suggest placing money **into** an investment machine, certainly does not teach or suggest placing a **coin** or a **bill** into the investment machine. The Office Action implies on page 19 that because Atkins discloses that it can track transactions that are performed through the accounts such as deposit or withdrawal of cash or purchase and sale of goods, services and securities, that this somehow is related to actually receiving a “coin” or a “bill” into the investment machine. It is not.

Tracking transactions that occur at another location through a computer interface is a far cry from actually receiving a coin or bill at the investment machine. Such a logical leap would be the same as saying that because a computer can display images of a person climbing Mount Everest, it would be obvious to adapt the computer to climb Mount Everest itself. The Atkins system displaying historical information about automated or non-automated transactions that occurred previously at different locations around the world, just because they may have involved money, does not make it obvious to place coins or bills into an investment machine to make an investment through that machine. Perhaps the historical record of the money is being confused

with the money itself. Until Applicant's invention as recited in claim 32, no one has created a system by which a person can drop coins or bills into an investment machine and select a current investment for the money put into the machine. Applicant does not dispute that coin and bill receivers are known for other applications, and that Internet investment and account tracking software exists. Applicant does dispute, however, that anyone has taught or suggested what is claimed by claim 32. Accordingly, claim 32 is allowable over and not made obvious by the combined teachings of Atkins and Donohue. Dependent claims 33 and 34 are allowable over the combination of Atkins and Donohue, among other reasons, for depending from allowable claim 32.

#### Claims 35-44

Claim 35 recites an investment machine for public use and display, the investment machine comprising, "at least one of a coin receiver and a bill receiver at least partially enclosed within the housing and configured to receive and identify money to be invested . . . ." The combination of Atkins and Donohue does not teach or suggest any coin receiver or bill receiver at an investment machine. Atkins deals solely with accounts at a bank or other money lending institution where large amounts of money are kept and transferred. There is no need for a coin or bill receiver in any system that would be combined from the teachings of Atkins and Donohue, though Applicant maintains there is no motivation to combine the references, because the money accounts being tracked already exist. To have a user input coins or bills into the machine that is tracking the other accounts makes no sense without Applicant's disclosure and there would be no motivation to do so without prior knowledge of Applicant's invention of claim 35.

Applicants respectfully request that the obviousness rejections of claims 1-17 and 32-44 be withdrawn.

In summary, none of the references cited by the Examiner nor any other known prior art, either alone or in combination, disclose the unique combination of features disclosed in Applicant's claims presently on file. For this reason, allowance of all of Applicants' claims is respectfully solicited.

**Regarding Doctrine of Equivalents**

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.



**CONCLUSION**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

Date: October 16, 2003

By Kenneth C. Booth  
Kenneth C. Booth  
Reg. No. 42,342

**SCHMEISER, OLSEN & WATTS LLP**

18 East University Drive, #101

Mesa, AZ 85201

(480) 655-0073

\\Sow\_az\_server\F\sow\Clients\Burden\Burd-0275\OA3\oar.wpd